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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,042	12/11/2003	Markley C. Leavitt	AVI-028	9363

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AVIGENICS, INC.
111 RIVERBEND ROAD
ATHENS, GA 30605

EXAMINER

WILSON, MICHAEL C

ART UNIT	PAPER NUMBER
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1632

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/733,042

Applicant(s)

LEAVITT ET AL.

Examiner

Michael C. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-70 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-41, drawn to a nucleic acid, classified in class 536, subclass 23.1, et al.
- II. Claims 42-54, drawn to a method of genetically altering an avian cell, classified in class 435, subclass 455, et al.
- III. Claims 55-61, drawn to a cell, classified in class 435, subclass 325.
- IV. Claims 62-66, drawn to a transgenic avian, classified in class 800, subclass 19.
- V. Claim 67, drawn to an egg, classified in class 426, subclass 47.
- VI. Claim 68, drawn to egg white, classified in class 426, subclass 32.
- VII. Claims 69 and 70, drawn to protein, classified in various classes and subclasses.

The inventions are distinct, each from the other because of the following reasons:

Groups I and II are patentably distinct because the nucleic acid can be used as a probe while the method of Group II can be used to alter avian cells in vitro or in vivo.

The protocols and reagents for each group are materially distinct and separate. The method does not require the nucleic acid and the nucleic acid does not require the method.

Groups I and III are patentably distinct because the nucleic acid can be used as a probe while the cell can be used to make a transgenic avian. The protocols and reagents for each group are materially distinct and separate. The nucleic acid does not require the cell and the cell does not require the nucleic acid.

Groups I and IV are patentably distinct because the nucleic acid can be used as a probe while the transgenic avian can be used as a bioreactor. The protocols and reagents for each group are materially distinct and separate. The nucleic acid does not require the transgenic and the transgenic does not require the nucleic acid.

Groups I and V are patentably distinct because the nucleic acid can be used as a probe while the egg can be used as food. The protocols and reagents for each group are materially distinct and separate. The nucleic acid does not require the egg and the egg does not require the nucleic acid.

Groups I and VI are patentably distinct because the nucleic acid can be used as a probe while the egg white can be used as food. The protocols and reagents for each group are materially distinct and separate. The nucleic acid does not require the egg white and the egg white does not require the nucleic acid.

Groups I and VII are patentably distinct because the nucleic acid can be used as a probe while the protein can be used to make antibody. The protocols and reagents for each group are materially distinct and separate. The nucleic acid does not require the protein and the protein does not require the nucleic acid.

Groups II and III are patentably distinct because the method can be used to transfect cells in vitro while the cell can be used to make a transgenic avian. The

protocols and reagents for each group are materially distinct and separate. The method does not using or making the cell and the cell does not have to be made by the method.

Groups II and IV are patentably distinct because the method can be used to transfect cells in vitro while the transgenic avian can be used as a bioreactor. The protocols and reagents for each group are materially distinct and separate. The method does not have to be used to make the transgenic and the transgenic does not have to be made by the method.

Groups II and V are patentably distinct because the method can be used to make transgenic avians while the egg can be used as food. The protocols and reagents for each group are materially distinct and separate. The method does not require the egg and the egg does not require the method.

Groups II and VI are patentably distinct because the method can be used to make transgenics while the egg white can be used as food. The protocols and reagents for each group are materially distinct and separate. The method does not require the egg white and the egg white does not require the method.

Groups II and VII are patentably distinct because the method can be used to make transgenics while the protein can be used to make antibody. The protocols and reagents for each group are materially distinct and separate. The method does not require the protein and the protein does not require the method.

Groups III and IV are patentably distinct because the cell can be used for research in vitro while the transgenic avian can be used as a bioreactor. The protocols and reagents for each group are materially distinct and separate. The cell does not

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have to be used to make the transgenic and the transgenic does not have to be made using the cell.

Groups III and V or VI are patentably distinct because the cell can be used for research in vitro while the egg/egg white can be used as food. The protocols and reagents for each group are materially distinct and separate. The cell does not require the egg and the egg does not require the cell.

Groups III and VII are patentably distinct because the cell can be used to make transgenics while the protein can be used to make antibody. The protocols and reagents for each group are materially distinct and separate. The cell does not require the protein and the protein does not require the cell.

Groups IV and V or VI are patentably distinct because the transgenic can be used as a model of disease while the egg/egg white can be used as food. The protocols and reagents for each group are materially distinct and separate. The transgenic does not require the egg and the egg does not require the cell.

Groups IV and VII are patentably distinct because the transgenic can be used as a model of disease while the protein can be used to make antibody. The protocols and reagents for each group are materially distinct and separate. The transgenic does not require the protein and the protein does not require the transgenic.

Groups V and VI are patentably distinct because the egg can be used as food while the egg white can be used to isolate proteins. The protocols and reagents for using each group are materially distinct and separate. The egg does not require the egg white and vice versa.

Groups V or VI and VII are patentably distinct because the egg/egg white can be used as food while the protein can be used to isolate antibodies. The protocols and reagents are materially distinct and separate. The egg/egg white does not require the protein and the protein does not require the egg/egg white.

The burden required to search any of the groups together would be undue.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson who can normally be reached at the office on Monday, Tuesday, Thursday and Friday from 9:30 am to 6:00 pm at 571-272-0738.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image

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problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Peter Paras, can be reached on 571-272-4517.

The official fax number for this Group is (571) 273-8300.

Michael C. Wilson

A handwritten signature in black ink, consisting of a series of vertical strokes followed by a long, sweeping horizontal line.

**MICHAEL WILSON
PRIMARY EXAMINER**